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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,154	12/06/2001	Richard T. Skiffington	0656-008US6	1022

7590

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EXAMINER

BEISNER, WILLIAM H

ART UNIT

PAPER NUMBER

1744

DATE MAILED: 08/14/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/014,154

Applicant(s)

SKIFFINGTON ET AL.

Examiner

William H. Beisner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 24-26 is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☒ Claim(s) 24-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements filed 06 Dec. 2001 and 06 March 2002 have been considered and made of record. Note with respect to the IDS 06 Dec. 2001, the following correction has been made: US Patent 4,978,504 has been changed to list Nason as the inventor rather than Habenstein and US Patent 5,077,200 has been listed with Habenstein as an inventor. Patent 5,077,200 was submitted with the IDS but not listed.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-6 and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 further limits the reagent composition of claim 1, however, claim 1 recites that the composition can be selected from three possible compositions. It is not clear from the language of claim 3 which of the three compositions is being further limited, if at all.

Claim 4 further limits the reagent composition of claim 1, however, claim 1 recites that the composition can be selected from three possible compositions. It is not clear from the language of claim 4 which of the three compositions is being further limited, if at all. Also, wouldn't the inclusion of a pH indicator materially affect the basic characteristics of the claimed composition which is limited by the language "consisting essentially of" recited in claim 1?

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The language of claim 5 is indefinite because it recites the combination of the chamber of claim 1 with a test apparatus, however, the language of claim 5 requires that the reagent composition be composition (i) of those listed in claim 1. It is suggested that the claim clearly recite that a chamber of claim 1 including reagent composition (i) is employed in the combination.

In claim 6, line 3, “the test” lacks clear antecedent basis. While the preamble of the claims recite detection of ATP or AP, the claims do not include positively recited language which identifies “the test”.

Claim 10 further limits the reagent composition of claim 1 (claim 10 indirectly depends from claim 1), however, claim 1 recites that the composition can be selected from three possible compositions. It is not clear from the language of claim 10 which of the three compositions is being further limited, if at all.

In claim 11, “the probe” lacks antecedent basis. Note claim 11 depends from claim 5 while the probe is first recited in claim 6. It is suggested that the claim be amended to depend from claim 6 rather than claim 5.

Claims 12 and 13 further limit the reagent composition of claim 1, however, claim 1 recites that the composition can be selected from three possible compositions. It is not clear from the language of claim 12 or 13 which of the three compositions is being further limited, if at all.

Reissue Applications

4. Claims 1-23 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Independent claims 1, 14 and 21 as well as dependent claims 10 and 19 have been amended to omit the language "tablet" or "in tablet form" which constitutes a broadening of the claims.

This broadening of the claims is considered to be recapture of surrendered subject matter for the following reasons:

The claims filed as a preliminary amendment in application 09/396,127 were rejected over the references of Matsumoto et al.(JP 07-59555) and Bernstein (US 4,770,853) (See the office action dated 22 Nov. 1999 (Paper No. 3)). In response to these prior art rejections, Applicants filed a response dated 17 April 2000, which included an amendment to all of the independent claims (claims 51, 63 and 73). The amendment to the independent claims included

the limitation that included the language "a reagent tablet". While applicants made no argument on the record that the tablet limitation was added to obviate the rejection, the nature of the addition to the claims can show that the limitation was added in direct reply to the rejection. This situation establishes that the omitted limitation relates to subject matter previously surrendered (See MPEP 1412.02 Example (B)).

Note new claims 24-26 are not encompassed by this rejection because they are of the same scope as originally patented claims 14, 21 and 23.

Allowable Subject Matter

5. Claims 24-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Note new claims 24-26 are not encompassed by the rejection under 35 USC 251 because they are of the same scope as originally patented claims 14, 21 and 23

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Beisner whose telephone number is 703-308-4006. The examiner can normally be reached on Tues. to Fri. and alt. Mon. from 6:40am to 4:10pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden can be reached on 703-308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



William H. Beisner
Primary Examiner
Art Unit 1744

WHB

July 29, 2002